



10 SEP 2003

#12

Fish & Richardson, P.C.
45 Rockefeller Plaza
Suite 2800
New York, NY 10111

In re Application of	:	DECISION ON RENEWED
DESMOTS et al.	:	
Application No.: 09/381,890	:	PETITION UNDER
PCT No.: PCT/GB98/00950	:	
Int. Filing Date: 30 March 1998	:	37 CFR 1.47(a)
Priority Date: 09 April 1997	:	
Attorney Docket No.: 08291/619001	:	
For: DIPALATORY COMPOSITIONS, THEIR	:	
PREPARATION AND USE	:	

This is a decision on applicants' "RENEWED PETITION UNDER 37 C.F.R. § 1.47(a)" filed in the United States Patent and Trademark Office (USPTO) on 04 March 2003 and the "SUPPLEMENT TO RENEWED PETITION UNDER 37 C.F.R. § 1.47(a)" filed in the USPTO on 28 March 2003.

BACKGROUND

On 30 March 1998, applicants filed international application PCT/GB98/00950, which claimed a priority date of 09 April 1997. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 15 October 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 04 November 1998, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 12 October 1999 (09 October 1999 being a Saturday and 11 October 1999 being a legal public holiday).

On 24 September 1999, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, an unexecuted declaration.

On 02 November 1999, a "Notification of Missing Requirements Under 35 USC 371" (Form PCT/DO/EO/905) was mailed to applicants requiring an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and surcharge fee under 37 CFR 1.492(e). A one month period for reply was set therein.

On 03 April 2000, applicants filed an executed declaration, surcharge fee under 37 CFR 1.492(e), and petition/fee for a four month extension of time. The declaration identified an

inventor's name not appearing in the published international application, i.e., Severine Poette, and failed to identify an inventor's name that does appear therein, i.e., Severine Hemery.

On 04 May 2000, a "Notification of Defective Response" (Form PCT/DO/EO/916) was mailed to applicants indicating that the declaration failed to identify the inventors.

On 05 June 2000, applicants filed a renewed petition indicating that Ms. Hemery's last name was changed to "Poette" as a result of marriage.

On 19 September 2000, a decision was mailed to applicants indicating that the petition under 37 CFR 1.182 regarding the name change of Ms. Hemery was granted. It was also noted, however, that the executed declaration filed 03 April 2000 failed to comply with 37 CFR 1.497(a). The decision stated that a new oath or declaration in compliance with 37 CFR 1.497(a)-(b) was required. A one month extendable time period was set.

On 19 March 2001, applicants submitted the instant "RESPONSE TO DECISION ON PETITION". The submission was accompanied by: declarations of inventors from each of David Acher, Gerd Dahms, Bruno Guillaume, and Severine Poette; a petition under 37 CFR 1.47(a) including declarations by Amanda J. Wilde; and a petition/fee for a five month extension of time.

On 23 April 2001, applicants submitted a "REQUEST FOR REFUND" requesting that the fees in the amount of \$130.00 and \$1,760.00 charged to Deposit Account No. 06-1050 be refunded as these fees were submitted by check on 19 March 2001.

On 21 August 2001, a decision was mailed to applicants indicating that the petition under 37 CFR 1.47(a) was dismissed. Specifically, it was noted that factual proof that the missing joint inventors refuse to execute the application or cannot be reached after diligent effort had not been provided nor was an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor provided. The decision also indicated that a new oath(s) or declaration(s) properly identifying all of the inventors and signed by all of the inventors, with the exception of any unavailable inventors under 37 CFR 1.47, was required.

On 08 March 2002, applicants filed a "RENEWED PETITION UNDER 37 C.F.R. § 1.47(a)", which was accompanied by, *inter alia*, declarations of inventors from David Acher and Gerd Dahms, a petition under 37 CFR 1.47(a) including a number of declarations of facts; and a petition/fee for a four month extension of time.

On 27 August 2002, a decision was mailed to applicants indicating that the petition under 37 CFR 1.47(a) was dismissed. Specifically, it was noted that factual proof that the missing joint inventors refuse to execute the application or cannot be reached after diligent effort had not been provided nor was an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor provided. The decision also indicated that a

new oath(s) or declaration(s) properly identifying all of the inventors and signed by all of the inventors, with the exception of any unavailable inventors under 37 CFR 1.47, was required.

On 04 March 2003, applicants filed a second "RENEWED PETITION UNDER 37 C.F.R. § 1.47(a)", which was accompanied by, *inter alia*, a petition/fee for a four month extension of time, a signed declaration from previously non-signing inventor Bruno Guillaume, and declarations and exhibits for each of the non-signing inventors Annick Canelas, Sarah Desmots, Philippe Ledon, and Severine Poette.

On 28 March 2003, applicants filed a "SUPPLEMENT TO RENEWED PETITION UNDER 37 C.F.R. § 1.47(a)" which was accompanied by, *inter alia*, a signed declaration from each of previously non-signing inventors Philippe Ledon and Severine Poette.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to (1), the fee of \$130.00 has been paid.

As to (3), a statement of the last known addresses of Annick Canelas and Sarah Desmots has been provided.

As to (2), the second renewed petition alleges that Annick Canelas refuses to sign. The steps enumerated in the "DECLARATION RE INVENTOR ANNICK CANELAS" by Mr. Rabin and the "DECLARATION RE INVENTOR ANNICK CANELAS" by Karen R. Grant and the "SECOND DECLARATION RE INVENTOR ANNICK CANELAS" by Christelle Leboucher-Madec and the translation of the note sent by Annick Canelas to Christelle Leboucher-Madec, all of which were submitted 04 March 2003, are sufficient to establish that Annick Canelas refuses to execute the application and that Annick Canelas was presented with a copy of the application including the specification, drawings, and claims. The renewed petition also alleges that Sarah Desmots cannot be reached after diligent effort. The "DECLARATION RE INVENTOR SARAH DESMOTS" by Mr. Rabin and the exhibits concerning Sarah Desmots, all of which were submitted 04 March 2003, are sufficient to establish that Sarah Desmots cannot be reached after diligent effort.

As to (4), the decision mailed 27 August 2002 indicated that it was not clear that each 37 CFR 1.47(a) applicant had signed on behalf of the non-signing joint inventors since the declarations accompanying the 08 March 2002 submission did not list the non-signing joint inventors. This decision noted that each executed declaration must identify all of the inventors.

and that the declarations filed 08 March 2002 listed only one inventor rather than all of the inventors. As noted by petitioner in the renewed petition filed 04 March 2003, the declarations filed 08 March 2002 did identify all of the inventors near the top of page 1 of each declaration. Thus, the statements made regarding the declarations of inventors in the decision mailed 27 August 2002 were incorrect. The declarations of inventors in compliance with item (4) and 37 CFR 1.497(a)-(b) are as follows:

- declaration of Gerd Dahms filed 08 March 2002;
- declaration of Hubert Delagneau filed 08 March 2002;
- declaration of David Acher filed 08 March 2002;
- declaration of Bruno Guillaume filed 04 March 2003;
- declaration of Philippe Ledon filed 28 March 2003; and
- declaration of Severine Poette filed 28 March 2003.

The declarations of inventors listed above satisfy item (4). These declarations are in compliance with 37 CFR 1.497(a)-(b).

CONCLUSION

For the reasons set forth above, applicants' renewed petition under 37 CFR 1.47(a) is **GRANTED**.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to each of the non-signing inventors at the last known address of record for each of them.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application, including the accordation of a 35 U.S.C. 371(c) date of **28 March 2003**.



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10 SEP 2003

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In re Application of
DESMOTS et al.
Application No.: 09/381,890
PCT No.: PCT/GB98/00950
Int. Filing Date: 30 March 1998
Priority Date: 09 April 1997
Attorney Docket No.: 08291/619001
For: DIPALATORY COMPOSITIONS, THEIR PREPARATION AND USE

Dear Ms. Desmots:

You are named as an inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

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In re Application of
DESMOTS et al.
Application No.: 09/381,890
PCT No.: PCT/GB98/00950
Int. Filing Date: 30 March 1998
Priority Date: 09 April 1997
Attorney Docket No.: 08291/619001
For: DIPALATORY COMPOSITIONS, THEIR PREPARATION AND USE

Dear Ms. Canelas:

You are named as an inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

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